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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/578,001 | 05/24/2000 | C. Daniel McClain | ROWL-9955 | 4546 |

23123 7590 05/12/2006

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| EXAMINER | |
|---|---|
| SANDERS, KRIELLION ANTIONETTE | |
| **ART UNIT** | **PAPER NUMBER** |
| 1714 | |

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/578,001 | MCCLAIN ET AL. | |
| | Examiner | Art Unit | |
| | Kriellion A. Sanders | 1714 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *23 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *89,92,95,98,101,104,107,110,113,116,119,122,125,134,137,140,146,149,158,161,164,167,170,173,182,185,188,194,197,206,208,210,212,214,216,218,220,222,224,226,228,230,232,234,236,238,240,242,244,246,248,250,252,254,256,258,260-285,301,303-307,309,310,312,313,315,319,327* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *89,92,95,98,101,104,107,110,113,116,119,122,125,134,137,140,146,149,158,161,164,167,170,173,182,185,188,194,197,206,208,210,212,214,216,218,220,222,224,226,228,230,232,234,236,238,240,242,244,246,248,250,252,254,256,258,260-285,301,303-307,309,310,312,313,315,319,327* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/06*
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

The pending claims of this application have been copied by the applicant from U.S. patent No. 6,531,537 or drafted as proposed counts to an Interference proceeding. These claims are not patentable to the applicant because they have been found to be unpatentable under 35 USC 112 and/or 35 USC 103. An Interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgment in the interference.

## *Objection to specification*

The amendment filed 3/232006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: All newly added language to pages 9 and 10 of the specification is considered new matter, since it was not part of the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action. Applicant has not clearly pointed out where in the original disclosure there is support for the added languge.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 89, 92, 95, 98, 101, 104, 107, 110, 113, 116, 119, 122, 125, 134, 137, 140, 146, 149, 158, 161, 164, 167, 170, 173, 182, 185, 188, 194, 197, 206, 208, 210, 212, 214, 216, 218, 220, 222, 224, 226, 228, 230, 232, 234, 236, 238, 240, 242, 244, 246, 248, 250, 252, 254, 256, 258, 260-285, 301, 303-307, 309, 310, 312, 313, 315, 319 and 327 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to describe the following claimed components of the presently claimed invention:

**The original disclosure does not provide clear support for the use of certain terms newly incorporated into the claims.** Applicant uses the term, "stable" to describe the prepaints of the claimed invention, yet, this term was not included in the original disclosure.

The phrase, "at least one of the prepaint compositions comprising at least one of calcined clay, silica, diatomaceous earth, ground limestone and mixtures thereof", is not supported by the

original disclosure. According to applicant's specification at pages 7 and 8, only certain of these components are utilized in certain premixed aqueous compositions.

Applicant's use of the terms, "pigment prepaints", "binder prepaints", "fluid prepaints", and "prepaints" are not included in the original specification. Applicant describes the components of his invention as "premixed aqueous compositions" and "premixed pigment compositions"

The specification does not describe a component wherein a premixed pigment composition further comprises at least one resinous binder adsorbed onto the opacifying pigment, extender pigment or flattening agent as set forth in claim 95.

Applicant's amendments to the specification do not overcome the rejections under 35 USC 112 1st Paragraph because the present claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, that applicant had possession of the claimed invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 301-303, 306, 313, 319 and 327 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei, US Patent No. 5,643,669.

Applicant's invention relates to a prepaint or composition comprising a combination of an opacifying pigment, a latex polymeric binder and a flattening agent. Tsuei discloses water based coating compositions which may be used to formulate paints. The compositions which possess a solids content of 30-705 per weight of composition comprise an acrylic based resin (urethane/acrylic), and may possess a thickener, a flattening agent and colorants such as titanium dioxide. See col. 3, lines 14-31, col. 4, lines 2-21, col. 6, lines 16-32, col. 7, lines 15-47, col. 9, lines 44-65 and col. 16, lines 39-64. Titanium dioxide is an opacifying pigment. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to select the a thickener, a flattening agent and titanium dioxide colorant set forth in Tsuei to formulate a paint e col. 6, lines 31-44. Patentee relates the viscosity in centipoises and does not address KU, however it would be obvious to the skilled artisan to adjust the viscosity of the paint compositions of Tsuei by altering the quantity of the thickening agent until the desired viscosity is achieved.

***Response to arguments***

Applicant's arguments filed 3/23/06 have not been found to be persuasive because applicant avers that Tsuei teaches to form paints as opposed to prepaints. Applicant also states that Tseui "does not teach to add the other essential paint elements as a separate prepaint, but teaches to mix them all together". Applicant also states that, "Each of the prepaints by themselves, are not intended to be paint by themselves but only after combination with other prepaint compositions." Applicant indicates that prepaints become paints only after combination with other prepaint compositions. Applicant states that Tseui teaches to mix all essential paint elements together. Applicant has not distinguished between a pre-paint and the compositions of Tseui. In either instance, all essential elements are mixed together to form a paint. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that each of the prepaints by themselves is not intended to be paint, but becomes an integral part of the paint only after combination with other prepaints) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's claim 89 for example is directed to "a plurality of varied premixed aqueous compositions", not to "prepaints which by themselves are not intended to be paint, but becomes an integral part of the paint only after combination with other prepaints".

## *Conclusion*

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Thursday 6:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kriellion A. Sanders
Primary Examiner
Art Unit 1714